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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,138	12/08/2000	Rajan Mathew Lukose	1508/3150 (A0856)	2121

7590 07/24/2003

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EXAMINER

FELTEN, DANIEL S

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 07/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/733,138

Applicant(s)
Lukose

Examiner
Daniel Felten

Art Unit
3624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 6, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

DETAILED ACTION

1
2 1. Receipt of the amendment filed April 23, 2003 amending of claims 13, 22 and 23 to
3 correct minor informalities. Claims 1-30 remain pending in the application and are presented to
4 be examined upon their merits
5

Response to Telephonic Interview

6
7

8 2. In response to a concern raised By Mr. John Campa (Reg. No. 49,014) during the
9 telephonic interview on May 6, 2003 regarding the secondary reference (Walker et al US
10 5,794,207) used to reject claims 1-30 under 35 USC § 103. During the interview, a further
11 review of Walker was suggested to find the citation that particularly reads on the limitation of,
12 "receiving a first payment for the information if at least one condition for the contingency is
13 satisfied after the information has been provided to the buyer". The examiner maintains that
14 this limitation is found in Walker, wherein payment by the buyer is contingent whether or not
15 the seller satisfies the buyers conditions. This information could be provided to the buyer by a
16 point value system, which may be added up to give an overall score wherein the buyer makes
17 payments once the information provided by the buyer is satisfied by the seller (see Walker,
18 col. 16, ll. 12-45). Again it is maintained that once the criteria is met a payment for the
19 contingency is made.
20


HANI M. KAZIMI
PRIMARY EXAMINER

1 3. A Courtesy copy of the previous office action dated December 19, 2002 has been
2 provided below:
3
4

5 ***Claim Rejections - 35 USC § 103***

6 4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
7 obviousness rejections set forth in this Office action:

8 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
9 section 102 of this title, if the differences between the subject matter sought to be patented and the prior art
10 are such that the subject matter as a whole would have been obvious at the time the invention was made to a
11 person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
12 negated by the manner in which the invention was made.
13

14 5. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tarbox
15 (US 6,154,732) in view of Walker et al (hereinafter "Walker", US 5,794,207).
16

17 Tarbox discloses all a method/system claims related to electronically selling information
18 (investment advise) to a buyer (investor), the wherein the method/system comprises receiving
19 an offer (fee(s)) for the information including at least one contingency from the buyer;
20 providing the information in response to the offer; and receiving a first payment for the
21 information if at least one condition for the contingency is satisfied after the information has
22 been provided to the buyer (see col.3, ll. 21+; col. 2, ll. 4-46). Tarbox fails to disclose
23 sending a counteroffer to the buyer based on the offer, however, this feature disclosed by
24 Walker (see at least col. 9, ll. 4-51). It would have been obvious for an artisan at the time of
25 the invention of Tarbox to integrate the counteroffer feature, as disclosed in Walker, because

1 an artisan at the time of the invention of Tarbox would have recognized that the ability to
2 counteroffer would allow the system to make recommendations that cater to participants
3 financial needs based upon available portfolio and/or allocation adjustments and the fees
4 associated with the execution and creation of the available portfolio and/or allocation
5 adjustments. Thus to allow the system to interactively adjust and negotiate through the
6 participants risk tolerances within the limitations of available resources would have constituted
7 an obvious expedient well within the ordinary skill in the art.

8
9
10 ***Conclusion***
11

12 6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time
13 policy as set forth in 37 CFR 1.136(a).

14 A shortened statutory period for reply to this final action is set to expire THREE
15 MONTHS from the mailing date of this action. In the event a first reply is filed within TWO
16 MONTHS of the mailing date of this final action and the advisory action is not mailed until after
17 the end of the THREE-MONTH shortened statutory period, then the shortened statutory period
18 will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR
19 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,
20 will the statutory period for reply expire later than SIX MONTHS from the mailing date of this
21 final action.
22
23

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Daniel S. Felten** whose telephone number is (703) 305-0724. The examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday. Any inquiry of a general nature relating to the status of this application or its proceedings should be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor **Vincent Millin** whose telephone number is (703) 308-1065.

8. Response to this action should be mailed to:

Commissioner of Patents and Trademarks


Washington, D.C. 20231

for formal communications intended for entry, or (703) 305-0040, for informal or draft communications, please label "Proposed" or "Draft".

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to *[daniel.felten@uspto.gov]*.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1 195 OG 89.


HANI M. KAZIMI
PRIMARY EXAMINER


DSF
July 15, 2003